

## REMARKS

After entry of this response, claims 21, 22, 26, 29, 30, 36, and 42 remain pending in the present application and new claims 43-55 are hereby added to the application. Applicant respectfully requests reconsideration by the Examiner in light of the following remarks.

### **Claim Objections**

The Examiner suggested modifications to claims 22 and 36 to correct minor errors in the claims as drafted. These suggestions have been incorporated in the above amendments to overcome the objections as to form of the claims.

### **Restriction Requirement**

The Examiner restricted examination of this application to claims 22, 29, 30, 36, and 42. Applicants respectfully request consideration of claims 21, and 26 in this Office Action as claim 21 is a generic claim for the group that has been amended so as to be allowable and claims 26 has been amended and depends from this claim. The species of claim 22 remains the elected species.

New claims 43-55 are consistent with the election of Group II. Claims 43 and 44 are directed toward grafting reagents with positively charged groups, as discussed below. Claim 46 is directed toward an embodiment of the elected species, while claim 45 is believed to be another allowable generic claim. If the Examiner does not find claim 45 allowable, Applicants elect to proceed with the prosecution of claim 46, which is readable on the elected species.

### **Claim Rejections**

The Examiner has rejected claims 22, 29, 30, and 36 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over U.S. Patent No. 6,669,994 in view of U.S. Patent No. 5,414,075. These claims have been amended to focus on grafting

reagents comprising positively charged groups. In light of these amendments, the Applicants respectfully traverse the rejection and the Examiners assertion that “U.S. Patent No. 6,669,994 meets all the structural limitations and chemistry as required by the claims” does not apply. However, to advance prosecution of this Application and to obtain allowance on allowable claims at the earliest possible date, the Applicants will file a terminal disclaimer in compliance with 37 CFR 1.321(c) to overcome the rejection based on a nonstatutory double patenting ground upon receiving notice of the allowance of the claims. It is noted that no admission may be inferred by this response or any terminal disclaimer filed in the present application and the Applicants reserve the right to pursue similar claims in the future.

Additionally, the Examiner has rejected claims 22, 29, 30, 36, and 42 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. WO 01/21326 (“WO ’326”). The Examiner’s position is that WO ’326 discloses every element of the claimed subject matter. Applicants respectfully disagree, and as discussed further below, WO ’326 does not anticipate the claims as amended in this response.

“For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the Claimed invention must be identically shown in a single reference.” In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). “Anticipation under 35 U.S.C. § 102(b) requires the presence in a single prior art disclosure of each and every element of a Claimed invention . . . .” Electro Medical Systems, S.A. v. Cooper Life Sciences, Inc., 34 F.3d 1048, 32 U.S.P.Q.2d 1017, 1019 (Fed. Cir. 1994). [O]ne who seeks such a finding must show that each element of the Claim in issue is found, either expressly or under principles of inherency, in a single prior art reference, or that the Claimed invention was previously known or embodied a single prior art

device or practice.” Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopedics, Inc., 976 F.2d 1559, 24 U.S.P.Q.2d 1321, 1326 (Fed. Cir. 1992).

The disclosure of the WO ’326 does not disclose a grafting agent that includes a positively charged substituent as required by amended claims 22, 29, 30, 36, and 42. The WO ’326 reference discloses only agents with negatively charged groups such as those pictured on page 8 of the publication. All reagents disclosed in the WO ’326 publication have negatively charged substituent groups, and none have positively charged groups. Since every single element of the claimed invention, as defined by the amended claims, is not disclosed in the WO ’326 publication, Applicants respectfully assert that this rejection is overcome.

The Examiner also rejected claims 22, 29, and 36 under 35 U.S.C. § 102(b) as being anticipated by WO 00/12575 (WO ’575) as evidenced by Swanson et al. U.S. 5,942,555. These claims, as amended, require a grafting agent with a positively charged substituent. WO ’575 does not disclose at least this limitation of the amended claims, and since every single element of the amended claims is not disclosed in the reference, the rejection under § 102(b) is overcome.

The Examiner also rejected claims 22, 29, 30, 36, and 42 under § 102(b) as being anticipated by U.S. Patent 5,414,075 to Swan et al. (the ’075 patent). The Applicants respectfully assert that the ’075 patent does not disclose graft polymerization as required by the claims. The ’075 patent discloses the immobilization of target molecules including synthetic polymers, carbohydrates, proteins, lipids, nucleic acids and drugs on a surface using a multifunctional reagent. These target molecules do not further react, but are simply immobilized on the surface by the reagent. Claims 22, 29, 30, 36, and 42 require the grafting of monomers to the surface under conditions suitable to cause the polymerization of monomers to the surface upon activation of the photoinitiator. The immobilization of target molecules disclosed in the

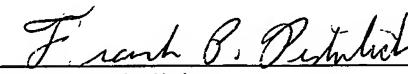
'075 patent does not anticipate the graft polymerization claimed in this application since the '075 patent neither discloses or makes obvious polymerization activated by the grafting reagent. The '075 patent does not disclose each and every limitation of the amended claims, and Applicants respectfully traverse the Examiner's conclusion that the '075 patent's disclosure anticipates the subject matter of these claims.

Applicants have amended certain claims solely to advance the prosecution of this application and to obtain allowance on allowable claims at the earliest possible date. Therefore, no admission may be inferred from the amendments to the claims herein and Applicants reserve the right to prosecute originally filed claims in later continuing applications.

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

If the Examiner believes that an Examiner's amendment would put this application in condition for allowance or would like to discuss this submission for any reason, Applicants would welcome the Examiner's input and respectfully request a telephonic interview. The Examiner may contact the undersigned at (612) 492-7305 to schedule such an interview if necessary.

Respectfully submitted,

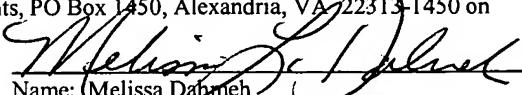
  
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